

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

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Serial No. : 10/629,108
Applicants : Kazuo KOYAMA et al.
Filed : July 28, 2003
For : BENZYLAMINE ANALOGUES
Art Unit : 1625
Examiner : Dr. Taofiq A. SOLOLA
Docket No. : 03338CIP/HG
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**RESPONSE TO DECISION ON REQUEST
FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT AND NOTICE OF INTENT TO
ISSUE CERTIFICATE OF CORRECTION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP PETITION

S I R :

This is in response to the DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION mailed August 3, 2009 (hereinafter referred to as the "August 3, 2009 DECISION"). The August 3, 2009 DECISION set a term of thirty days or one month, whichever is longer from the mail date of the August 3, 2009 DECISION, to respond, i.e., by September 3, 2009.

A. BACKGROUND

1. Patentees thank Senior Petitions Attorney Christina Tartera Donnell for granting patentees' request in the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN AN ISSUED PATENT (37 CFR §1.705(d)" filed May 8, 2009 (hereinafter referred to as the "May 8, 2009 APPLICATION FOR PTA") to rescind the twenty-three day reduction of patent term adjustment associated with patentees' December 12, 2008 filing of a "LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT."

2. This paper is being submitted to request reconsideration of the denial in the August 3, 2009 DECISION to rescind the 65 day reduction of patent term adjustment ("PTA") requested in the May 8, 2009 APPLICATION FOR PTA associated with patentees' January 12, 2009 filing of a LETTER RE: USPTO COMMUNICATION DATED DECEMBER 11, 2008.

3. The present patent term adjustment is 81 days, as indicated in the August 3, 2009 DECISION. For the reasons set forth hereinbelow, it is respectfully requested that the patent term adjustment be increased by the aforesaid 65 days to afford patentees a patent term adjustment of 146 days.

B. REASONS FOR REQUESTING RECONSIDERATION
OF THE AUGUST 3, 2009 DECISION WITH
RESPECT TO THE 65 DAY REDUCTION OF PTA

1. Patentees received from the USPTO a NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT dated December 9, 2009 (hereinafter referred to as the "December 9, 2009 NOTICE"), which stated that applicants' INFORMATION DISCLOSURE STATEMENT ("IDS") filed October 24, 2008 was not compliant with 37 CFR 1.97(d) because the IDS lacked a statement as specified in 37 CFR 1.97(e).

Specifically, the December 9, 2009 NOTICE stated as follows:

"An Information Disclosure Statement (IDS) filed 10/24/08 in the above-identified application fails to meet the requirements of 37 CFR 1.97(d) for the reason(s) specified below. Accordingly, the IDS will be placed in the file, but the information referred to therein has not been considered.

The IDS is not compliant with 37 CFR 1.97(d) because:

The IDS lacks a statement as specified in 37 CFR 1.97(e)."

2. In reply to the December 9, 2009 NOTICE, on December 12, 2009, patentees filed a LETTER RE: NOTICE OF NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT (hereinafter referred to as the "December 12, 2009 LETTER").

In patentees' December 12, 2009 LETTER, it was stated that patentees' IDS filed October 24, 2008 was filed after the submission of a RCE on October 8, 2008 and before the mailing of a Notice of Allowance on November 18, 2008, and therefore it was timely filed under 37 CFR 1.97(a)(4).

3. In reply to the December 12, 2009 LETTER, a USPTO COMMUNICATION dated December 31, 2008 was issued (hereinafter referred to as the "December 31, 2008 USPTO COMMUNICATION").

The following was stated in the December 31, 2008 USPTO COMMUNICATION:

"The papers filed on 10/24/08 are timely filed but they are Office Actions sent to an Examiner who issued the actions as well as IDSs previously considered and signed by the same Examiner. **Informing the Examiner of his Office Actions and/or previous IDSs does not constitute a proper IDS** as there is nothing to inform or disclose to the Examiner which he/she didn't know. This has the potential to cause serious confusion with the Office Legal Instrument Examiners and returning an Examiner's action to him/her has the potential of wasting time and delaying prosecution." (emphasis provided)

The only statement necessary in the December 31, 2008 USPTO COMMUNICATION was for the Examiner to state that patentees' IDS filed October 24, 2008 was compliant pursuant to 37 CFR 1.97(a)(4). However, the Examiner did not state this. Instead, the Examiner stated the copies of the Office Actions (in

copending family member applications) submitted with the October 25, 2008 IDS "does not constitute a proper IDS." As discussed hereinbelow, this statement is totally inaccurate and unnecessarily introduced a potentially harmful statement in the record, which necessitated a rebuttal by patentees.

The Examiner did not stop there. The Examiner went on to state that the submission of copies of such Office Actions "has the potential to cause serious confusion with the Office Legal Instrument Examiners and returning an Examiner's action to him/her has the potential of wasting time and delaying prosecution." As discussed hereinbelow, the aforesaid statement is contrary to the USPTO practice set forth in the USPTO MPEP and to the law. The statement unnecessarily and erroneously may cast doubt on the patentees' intention to satisfy their duty of disclosure and candor.

The statements made by the Examiner in the December 31, 2008 USPTO COMMUNICATION were not set forth in the December 9, 2009 NOTICE.

4. In order to set the record "straight" and reply to the Examiner's misstatements of USPTO practice and the law, patentees were thus compelled to file a paper in reply to the December 31, 2008 USPTO COMMUNICATION. Patentees thus filed on January 12, 2009 a LETTER RE: USPTO COMMUNICATION DATED DECEMBER 31, 2008 (hereinafter referred to as the "January 12, 2009 LETTER"). It

was the filing of the January 12, 2009 LETTER that resulted in an erroneous reduction of 65 days of patent term adjustment, the reversal of which is being requested herein.

The January 12, 2009 LETTER was patentees' first opportunity to reply to the Examiner's erroneous statements in the December 31, 2008 USPTO COMMUNICATION.

As discussed hereinabove, the December 31, 2008 USPTO COMMUNICATION referred to copies of Office Actions in copending family member applications that were submitted in patentees' IDS filed on October 24, 2008. In the January 12, 2009 LETTER, it was asserted that the October 24, 2008 IDS was a proper Information Disclosure Statement in that it presented material information with respect to patentability, i.e., copies of Office Actions in copending family member applications. The submission of copies of Office Actions in copending related applications was held to be an appropriate procedure in McKesson Information Solutions, Inc. v. Bridge Medical, Inc., 82 USPQ 2d 1865, 1885 (Fed. Cir. 2007). The following is stated in 82 USPQ 2d 1885:

"Moreover, the MPEP at the time explained that a prosecuting attorney should not assume that [a PTO examiner] retains details of every pending file in his mind when he is reviewing a particular application. MPEP §2001.06(b) (5th ed. rev. 3, 1986) (quoting *Armour & Co. v. Swift & Co.*, 466, F.2d 767,779 [175 USPQ 70] (7th Cir. 1972)), and PTO regulations required all disclosures to

be in writing, 37 C.F.R. §1.2; see also MPEP §2002.02 (5th ed. rev. 3, 1986)."

D. It is respectfully submitted that the reasons set forth in the August 3, 2009 DECISION which denied patentees' request to rescind the sixty-five days of patent term adjustment based on the filing of the January 12, 2009 LETTER are incorrect.

The following was stated on page 4, lines 5 to 14 of the August 3, 2009 DECISION:

"Unlike the circumstances surrounding the filing of 'LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT' on December 12, 2008, the filing of the 'LETTER RE: USPTO COMMUNICATION DATED DECEMBER 31, 2008' was not the first opportunity to raise the matter. Rather, patentees had already addressed this issue with the Examiner by filing the 'LETTER RE: NON-COMPLIANT INFORMATION DISCLOSURE STATEMENT' on December 12, 2008, and it was resolved by the Examiner in the Office communication mailed on December 31, 2008. Therefore, the reduction of sixty-five (65) days is merited and will remain."

The above quoted statements in the August 3, 2009 DECISION that patentees had already addressed the issues with the Examiner by filing their December 12, 2008 LETTER and was resolved by the Examiner in the December 31, 2008 USPTO COMMUNICATION are incorrect.

As discussed hereinabove, the December 31, 2008 USPTO COMMUNICATION raised serious issues that were not raised in the

December 9, 2009 NOTICE. The December 31, 2008 USPTO COMMUNICATION stated that patentees' IDS filed on October 24, 2008 did "not constitute a proper IDS." The filing of the January 12, 2009 LETTER was patentees' first opportunity to respond to the gross misstatements raised for the first time in the December 31, 2008 USPTO COMMUNICATION.

Contrary to the allegation on page 4, lines 5 to 14 of the August 3, 2009 DECISION, rather than resolve the issue of the IDS filed on October 24, 2008, the Examiner confused the issue and clouded the record.

C. CONCLUSION

It is respectfully submitted that patentees should not be penalized by a loss of sixty-five days of patent term adjustment for attempting to correct and clarify the record, which was distorted by misstatements and misunderstandings of the law by the Examiner.

It is therefore respectfully submitted that the 65 day
applicant delay be rescinded.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Richard S. Barth". The signature is fluid and cursive, with a large loop at the end of the last name.

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